

PRE-APPEAL BRIEF REQUEST FOR REVIEW
- Expedited Examining Procedure -
Examining Group 3724

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Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Inventor(s):
Manico, et al.

Group Art Unit: 2622
Examiner:
James M. Hannett

TITLE: METHOD OF USING A
PORTABLE SYSTEM FOR
CAPTURING IMAGES

Serial No.: 10/017,831
Filed: December 7, 2001

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request pre-appeal brief review of the Final Office Action dated 6 February 2007, in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The claims stand as entered from Applicants' amendment submitted 9 November 2005.

Allowed Claims

Claims 2-7, 9, and 16-22 are indicated as containing allowable subject matter. As set forth below, Applicants submit all pending claims 1-7, 9-11, and 13-27 are in condition for allowance.

Rejection of Claims 26 and 27 Under 35 U.S.C. §102(e) over Ueda et al.

Claims 26 and 27 remain rejected over Ueda et al., US Pat. 6,429,923. As indicated in the response filed 13 June 2006, incorporated herein by reference, claims 26 and 27 exactly conform to the Examiner's stated reasons for allowance of claims 2-7, 9, and 16-22. The Examiner did not respond to Applicants' arguments in this regard, and therefore has not clarified the issues as to why claims 26 and 27 are

rejected when they correspond to the Statement of Reasons for Allowance in the final Office Action of 6 February 2007, page 11, and the previous Office Action of 14 March 2006, page 10. The Examiner has expressly admitted twice on the record that the claimed combination of features in claims 26 and 27 is not taught by the prior art. Therefore, there is no prima facie case of anticipation made by the Examiner, and the rejection should be withdrawn.

Rejection of Claims 1, 10, 11, 13-15, and 23-25 Under 35 U.S.C. §103(a)

Claims 1, 10, 11, 13-15, and 23-25 remain rejected over Ueda et al., US Pat. 6,429,923. The independent claims are 1, 10, and 11, from which all other claims depend. Applicants herein incorporate at least the arguments set forth in the response filed 13 June 2006.

As stated in the final Office Action at page 5, it is “installing the *photographic processing apparatus* in a photo-shop” that is read by the Examiner to be equivalent to the claimed feature of “a service provider transporting a portable imaging device from a first location to a second location.” The Examiner argues on page 2: “It would have been an obvious matter of design choice to make the imaging system of Ueda et al small enough to be carried by hand, since such a modification would have involved a mere change in the size of a component.” The Examiner notes at page 2 neither a change in size nor making an old device portable is typically patentable. There is no explanation of how a *photographic processing apparatus*, which typically includes wet chemicals, paper, imaging lenses, and the like, would readily be reduced to something “small enough for the service provider to carry ... *by hand*,” as set forth in claims 1, 10, and 11. Reducing a photographic processing apparatus to a hand-held size would be a feat, and requires much more than “a mere change in size of *a* component,” but rather a drastic change in size of *every* component. Further, transfer of such a system of any size requires draining of wet chemicals before transport, and refilling of the same after transport, as well as other set-up. The complexity of moving such a system from location to location is *avoided* by Applicants’ system, which is not a photographic processor, but a hand-held portable imaging device. No movement of an equivalent device to Applicants’ claimed portable imaging device from one location to another is taught or suggested by Ueda et al. Thus, a prima facie case

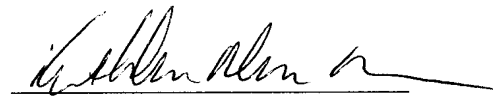
of obviousness with regard to claims 1, 10, and 11, and all claims dependent therefrom, has not been made.

With regard to claim 11 and the claims dependent therefrom, the additional feature of the service provider receiving a credit from the sponsor is required. The Examiner takes official notice of fee-splitting arrangements between "a convenience store which collects film cartridges and the processing facility" at page 9 of the final Office Action. However, claim 11 requires a *sponsor* provide a credit to the service provider. The *sponsor* is not fee sharing as the sponsor receives no fees from the production of the image product. Thus, a prima facie case of obviousness with regard to at least claims 11 and 13-15 has not been made.

As set forth above, the final rejection is clearly in error, prima facie cases of anticipation and obviousness not having been established.

A prompt and favorable action in response to this request is earnestly solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.